

REMARKS

By this amendment, the claims 1, 3 and 13 have been amended. Claims 20-21 were previously canceled. Claims 1-19 remain in the application. Support for the amendments can be found the specification and drawings. No new matter has been added. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, is requested.

Rejection under 35 U.S.C. §102

Claim 1

Claim 1 recites a method for managing the recording capacity of a recording device when scheduling the recording of an item, comprising:

- receiving data representing a plurality of recording modes of the recording device;
- for each recording mode of the plurality of recording modes, calculating a capacity required to record said item using the respective recording mode;
- obtaining a prevailing unreserved recording capacity of the recording device;
- identifying, for the recording of said item, a number of recording modes of the plurality for which a corresponding calculated capacity is less than the prevailing unreserved recording capacity; and
- responsive to one or more recording modes of the plurality being identified for the recording of said item,
 - o selecting a particular identified recording mode of the one or more identified recording modes based on a preference, wherein the preference includes criteria that define a set of acceptable recording modes associated with said item; and

- responsive to the particular identified recording mode being selected, scheduling the recording of said item using the selected recording mode, wherein the scheduled recording of said item becomes a reserved item, and wherein the receiving, obtaining, identifying, selecting, and scheduling are independent of user involvement.

Support for the amendments to claim 1 (as well as for claim 3 and 13) can be found in the specification at least on page 5, lines 4-12; page 6, lines 15-17; and page 7, lines 6-24.

As presented herein, claim 1 now more clearly articulates the novel and non-obvious distinct features thereof, as discussed below. Claim 1 is directed to a method for managing the recording capacity of a recording device when scheduling the recording of an item. The method includes receiving data representing a plurality of recording modes of the recording device (e.g., *with respect to a given single recording device*). For each recording mode of the plurality of recording modes [*of the single recording device*], a capacity required to record said item using the respective recording mode is calculated. In other words, a capacity required to record the item is calculated for each recording mode of the recording device. For example, if the number of recording modes of the recording device is three (e.g., SP, LP, and EP), then the method will calculate a corresponding number of capacities (e.g., three corresponding capacities, one capacity for SP, one capacity for LP, and one capacity for EP). Accordingly, the number of recording modes of the recording device determines the number of capacities that are calculated for scheduling the recording of the item.

A prevailing unreserved recording capacity of the recording device is then obtained. The method further includes identifying, for the recording of said item, a number of recording modes of the plurality for which a *corresponding* calculated capacity (*i.e.*, *one calculated capacity per recording mode of the single recording*

device) is less than the prevailing unreserved recording capacity. Responsive to one or more recording modes of the plurality being identified for the recording of said item, the method selects a particular identified recording mode of the one or more identified recording modes based on a *preference*. The preference includes criteria that define a set of acceptable recording modes associated with said item. In addition, responsive to the particular identified recording mode being selected, the method includes scheduling the recording of said item using the selected recording mode. The scheduled recording of said item becomes a reserved item. Lastly, the receiving, obtaining, identifying, selecting, and scheduling are independent of user involvement.

The method according to claim 1 advantageously identifies (i) that one or more recording modes are available to record the item *and* (ii) that one of those identified modes matches a preference. In addition, the method, and more particularly, the various steps of the method, are independent of user involvement. (See, *for example*, the specification at least on page 2, lines 21-32; page 3, lines 24-32; page 4, lines 1-8; page 5, lines 4-14; page 6, lines 14-17; page 7, lines 7-24; and page 16, lines 15-23).

Claims 1 and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by **Gunji** et al. (US 7,212,725, hereinafter referred to as “**Gunji**”). Applicant respectfully traverses this rejection for at least the following reasons.

The PTO provides in MPEP § 2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim....”

Therefore, with respect to claim 1, to sustain this rejection the **Gunji** reference must contain all of the above claimed elements of the respective claims. However, contrary to the examiner’s position that all elements are disclosed in the **Gunji** reference, the latter reference does not disclose a method that includes “for each recording mode of the plurality of recording modes [*of the recording device*] ... calculating a capacity required to record said item using the respective recording mode

[*of the recording device*] ... identifying, for the recording of said item, a number of recording modes of the plurality for which a corresponding calculated capacity is less than the prevailing unreserved recording capacity ... and responsive to ... recording modes of the plurality being identified for the recording of said item ... selecting a particular identified recording mode of the ... identified recording modes based on a preference, wherein the preference includes criteria that define a set of acceptable recording modes associated with said item ... and wherein the receiving, obtaining, identifying, selecting, and scheduling are independent of user involvement" [emphasis added] as is claimed in claim 1. Therefore, the rejection is not supported by the **Gunji** reference and should be withdrawn.

In contrast, the **Gunji** reference discloses a recording/reproducing apparatus and picture recording reservation method for a *plurality* of recordable/reproducible *media* (emphasis added) such as hard disks or recordable/reproducible DVDs (See **Gunji**, at col. 1, lines 20-25, and FIGs. 1-4). The apparatus and method of **Gunji** includes calculating a remaining capacity of a recording medium when a picture recording reservation is made so as to *permit the user* to easily understand the reservation status and whether the reservation recording is possible or not (See **Gunji**, Abstract). Further as disclosed in **Gunji**, the recording/reproducing apparatus includes a means for displaying a list of the recording reservation information on a monitor, a calculation means for calculating required reservation capacity when one or a plurality of picture recording reservation items are selected from the list, and a result displaying means for displaying result information indicating possible or impossible picture recording obtained from the relation between the reservation capacity and the remaining capacity of the recording medium which is a to-be-recorded object (See **Gunji**, col. 2, lines 51-60).

Gunji discloses a picture recording reservation input screen 310 (FIG. 2) and a picture recording reservation list screen 350 (FIG. 3) that are displayed on a display, for example, *in response to* a picture recording reservation key operation of the user (See **Gunji**, col. 8, lines 42-47). For picture recording reservations, the user makes

reservation selections, including the recording mode to be used (e.g., manual, SP, LP) by selecting any one of manual, SP, LP (e.g., on the reservation input or list screens) (See Gunji, col. 10, lines 53-60). In further contrast, the recording/reproducing apparatus and picture recording reservation method of **Gunji** requires **user involvement**, for example, as evidenced in at least column 8, line 46-47, which states “by the picture recording reservation key **operation of the user**”; column 9, lines 3-5, which states “a reservation information input position (row) is **set by moving a cursor** 311 on the left side”; and column 10, lines 6-7, which states “the **user can easily confirm** the reliability of the picture recording reservation”; and column 10, lines 56-57, which states “the **user makes mode selection** and moves the cursor to a desired row.” However, **Gunji** neither discloses or suggests “for each recording mode of the plurality of recording modes [of the recording device] ... calculating a capacity required to record said item using the respective recording mode [of the recording device] ... identifying, for the recording of said item, a number of recording modes of the plurality for which a corresponding calculated capacity is less than the prevailing unreserved recording capacity ... and responsive to ... recording modes of the plurality being identified for the recording of said item ... selecting a particular identified recording mode of the ... identified recording modes based on a preference, wherein the preference includes criteria that define a set of acceptable recording modes associated with said item. The **Gunji** reference further does not disclose or suggest a method “wherein the receiving, obtaining, identifying, selecting, and scheduling are independent of user involvement” as claimed.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested. Claim 12 depends from and further limits independent claim 1 and therefore is allowable as well. The 35 U.S.C. §102(e) rejection thereof has now been overcome.

Rejection under 35 U.S.C. §103

Claims 2-10 and 13-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as “**Gunji**”) in view of **Imada** et al. (US 7,254,318, hereinafter referred to as “**Imada**”).

With respect to claims 2, 9 and 10, the rejection is respectfully traversed for at least the following reason. Claims 2, 9 and 10 depend from and further limit allowable independent claim 1 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

With respect to claim 3, this rejection is traversed for at least the following reasons.

Claim 3

Claim 3 recites a method for managing the recording capacity of a recording device when recording an item, comprising:

- receiving data representing a plurality of recording modes of the recording device;
- selecting a recording mode of the plurality of recording modes based on a preference, wherein the preference includes criteria that define a set of acceptable recording modes associated with said item;
- commencing the recording of said item using the selected recording mode; and
- while recording the item:
 - o obtaining a prevailing unreserved recording capacity of the recording device; and
 - o responsive to the prevailing unreserved recording capacity for recording of said item using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any initial

portion of said item already recorded using the selected recording mode becomes a reserved item subject to being adapted; and

- determining whether recording of said item is finished, wherein (i) responsive to being finished, ending the recording, and (ii) responsive to being unfinished, continuing the recording commencing with the obtaining step, and wherein the receiving, selecting, commencing, recording, obtaining, adapting, determining, ending, and continuing are independent of user involvement.

Support for the amendments to claim 3 (as well as for claim 13) can be found in the specification at least on page 5, lines 4-12; page 6, lines 15-17; and page 7, lines 6-24.

Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 3.

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The **Gunji** and **Imada** patents cannot be applied to reject claim 3 under 35 U.S.C. §103 which provides that:

A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis

added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither **Gunji** nor **Imada** teaches managing the recording capacity of a recording device when recording an item comprising “... selecting a recording mode of [a] plurality of recording modes based on a preference, wherein the *preference* includes criteria that define a set of acceptable recording modes associated with said item ... obtaining a prevailing unreserved recording capacity of the recording device ... responsive to the *prevailing* unreserved recording capacity for recording of *said item* using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any *initial portion* of said item already recorded using the selected recording mode becomes a *reserved item* subject to being adapted; and determining whether recording of *said item* is finished, wherein (i) responsive to being *finished*, *ending* the recording, and (ii) responsive to being *unfinished*, *continuing* the recording commencing with the *obtaining step*... **and** wherein the *receiving*, *selecting*, *commencing*, *recording*, *obtaining*, *adapting*, *determining*, *ending*, and *continuing* are independent of user involvement” (emphasis added) as is claimed in claim 3, it is impossible to render the subject matter of claim 3 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case, the **Gunji** reference, by necessitating user involvement, for example, as evidenced in at least column 8, line 46-47, which states “by the picture recording reservation key **operation of the user**”; column 9, lines 3-5, which states “a

reservation information input position (row) is **set by moving a cursor** 311 on the left side"; and column 10, lines 6-7, which states "the **user can easily confirm** the reliability of the picture recording reservation"; and column 10, lines 56-57, which states "the **user makes mode selection** and moves the cursor to a desired row" teaches away from *receiving, selecting, commencing, recording, obtaining, adapting, determining, ending, and continuing being independent of user involvement.* Thus, this system clearly teaches away from claim 3, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another compelling reason why the **Gunji** and **Imada** patents cannot be applied to reject claim 3 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.

Here, neither **Gunji** nor **Imada** teaches, or even suggests, the desirability of the combination since neither teaches the specific managing the recording capacity of a

recording device when recording an item comprising "... selecting a *recording mode* of [a] plurality of recording modes based on a preference, wherein the *preference* includes criteria that define a set of acceptable recording modes associated with said item ... obtaining a *prevailing unreserved recording capacity* of the recording device ... responsive to the *prevailing unreserved recording capacity* for recording of *said item* using the selected recording mode being less than a pre-determined amount, adapting at least one reserved item, wherein any *initial portion* of *said item* already recorded using the selected recording mode becomes a *reserved item* subject to being adapted; and determining whether recording of *said item* is *finished*, wherein (i) responsive to being *finished*, *ending* the recording, and (ii) responsive to being *unfinished*, *continuing* the recording commencing with the *obtaining step*... **and** wherein the *receiving*, *selecting*, *commencing*, *recording*, *obtaining*, *adapting*, *determining*, *ending*, and *continuing* are independent of user involvement" as specified above and as claimed in claim 3.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection.

In this context, the MPEP further provides at § 2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 3. Therefore, for this reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should

be withdrawn.

With respect to claims 4-8, the rejection is respectfully traversed for at least the following reason. Claims 4-8 depend from and further limit allowable independent claim 3 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

With respect to claim 13, this rejection is respectfully traversed for at least the following reason. Claim 13 has been amended in a similar manner as the amendments to claims 1 and 3. For reasons similar to those presented herein above with respect to overcoming the rejections of claims 1 and 3, claim 13 is believed allowable and the rejection under 35 U.S.C. §103 should be withdrawn. With respect to claims 14-17, the rejection is respectfully traversed for at least the following reason. Claims 14-17 depend from and further limit allowable independent claim 13 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as “**Gunji**”), in view of **Imada** et al. (US 7,254,318, hereinafter referred to as “**Imada**”), further in view of **Ellis** et al (US 2002/0174430, hereinafter referred to as “**Ellis**”). With respect to claim 11, the rejection is respectfully traversed for at least the following reason. Claim 11 depends from and further limits allowable independent claim 1 and therefore is allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Claims 18-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over **Gunji** et al. (US 7,212,725, hereinafter referred to as “**Gunji**”), and well known prior art. With respect to claims 18-19, the rejection is respectfully traversed for at least the following reason. Claims 18-19 depend from and further limit allowable independent

claim 13 and therefore are allowable as well. The 35 U.S.C. §103(a) rejection thereof has now been overcome.

Conclusion

Except as indicated herein, the claims were not amended in order to address issues of patentability and Applicants respectfully reserve all rights they may have under the Doctrine of Equivalents. Applicants furthermore reserve their right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or a continuation application.

It is clear from all of the foregoing that independent claims 1, 3 and 13 are in condition for allowance. Claims 2 and 10-12 depend from and further limit independent claim 1 and therefore are allowable as well. Claims 4-9 depend from and further limit independent claim 3 and therefore are allowable as well. Claims 14-19 depend from and further limit independent claim 13 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced. An early formal notice of allowance of claims 1-19 is requested.

Respectfully submitted,

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Dated: October 20, 2009
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a-32658.302